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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,590	02/06/2002	Yasuhito Eto	219279US3	5468
22850	7590	07/16/2003		EXAMINER
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GUADALUPE, YARITZA	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Application No.	Applicant(s)	100
	10/066,590	ETO ET AL.	
	Examiner	Art Unit	
	Yaritza Guadalupe	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period f r Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 02 May 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-5,7 and 8 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,7 and 8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

In response to Amendment filed May 2, 2003

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1 – 8 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Shibata ( US 6,409,574 ).

Shibata discloses a lens processing apparatus comprising a lens fixing jig installed in a lens to be processed to clamp the lens, a lens rotation shaft ( 702L, 702R ) for clamping and rotating the lens to be processed ( See Columns 9 and 10, lines 66 – 67 and 1 – 3 respectively ), a measuring element ( See Column 1, lines 50 – 53 ) abutted on a refracting surface of the lens clamped by the lens rotation shaft, a measuring unit for measuring a moving distance of the measuring element ( See Column 2, lines 10 – 13 ), and an arithmetic control means for

identifying a shape of the lens fixing jig based on the moving distance of the measuring element measured by the measuring unit ( See Column 2, lines 65 – 67 ).

With respect to claim 2, Shibata further discloses the said lens rotation shaft being swung to be brought to contact or separated from the measuring element ( See Figure 13 and Columns 10 – 11, lines 47 – 63 and 44 – 67 respectively ).

Regarding claim 3, Shibata also discloses said measuring element including a pair of feelers ( 515, 517 ) to be brought into contact with the lens to be processed ( See Figure 13 ).

With respect to claim 4, Shibata discloses said measuring unit including a measuring element moving amount detecting mechanism ( See Column 2, lines 11 – 13 ).

Regarding claims 1, 5 and 7 - 8, Shibata discloses said arithmetic control means controlling the rotation of the lens shaft according to a measuring element moving amount detected from the measuring unit and also measuring the size of an outer shape of said lens fixing jig based on a signal from the measuring unit ( See Columns 13 and 14, lines 34 – 67 and 14 - 65 ). Shibata clearly discloses in the specification the process of moving each feeler ( 280 ) actuated by a motor ( 254, 270 ) in order to allow rotation so as to measure the size of the outer shape of the lens based on the movement detected by the encoder and control unit.

With respect to claims 7 - 8, Shibata discloses a lens processing apparatus comprising a lens fixing jig installed in a lens to be processed to clamp the lens, a lens rotation shaft ( 702L, 702R ) for clamping and rotating the lens to be processed ( See Columns 9 and 10, lines 66 – 67 and 1 – 3 respectively ), a measuring element ( See Column 1, lines 50 – 53 ) abutted on a refracting surface of the lens clamped by the lens rotation shaft, a measuring element rotating means for controlling rotation of the measuring element around a rotation shaft parallel to the lens rotation shaft ( See Columns 11 and 12, lines 45 – 47 and 45 – 56 respectively ), a measuring unit for measuring a moving distance of the measuring element in a direction parallel to the lens rotation shaft ( See Column 2, lines 10 – 13 ), and an arithmetic control means for rotating a tip of the measuring element around the lens rotation shaft and identifying a shape of the lens fixing jig based on the distance of the abutted position of the tip of the measuring element from a measuring element reference position ( See Column 2, lines 65 – 67 ).

***Response to Arguments***

3. Applicant's arguments filed May 2, 2003 have been fully considered but they are not persuasive.

Applicant arguments regarding the arithmetic control means are not persuasive. Shibata clearly teaches the use of a control means and encoder to measure the size of an outer shape of the lens based on the signal sent by the measuring unit / feelers movement and rotation ( See Columns 13 and 14, lines 34 – 67 and 14 – 65 ).

Furthermore, it should be emphasized that "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphasized in original). That is, in an apparatus claim, if a prior art structure discloses all of the structural elements in the claim, as well as their relative juxtaposition, then it reads on the claim, regardless of whether or not the function for which the prior art structure was intended is the same as that of the claimed invention. Therefore, the control unit disclosed by Shibata is capable to perform the process of measuring a size of an outer shape of the lens fixing jig based on a signal from the measuring unit if programmed to do so, since it only involves the use of an adequate software or programming by the user.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676. The examiner can normally be reached on 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9318 for regular communications and (703)872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Yaritza Guadalupe  
Patent Examiner  
Art Unit 2859  
July 8, 2003

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